



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,360	03/29/2001	Suruliappa Gowper Jeganathan		1176

324 7590 03/13/2003

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

WALKE, AMANDA C

ART UNIT PAPER NUMBER

1752

DATE MAILED: 03/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/806,360

Applicant(s)

JEGANATHAN ET AL.

Examiner

Amanda C Walke

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2002 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Birbaum et al (5,597,854). Column and line citations are for the U.S. Patent.

Birbaum et al disclose a silver halide photographic material containing a stabilizer meeting the structural limitations of the present claims (column 29, lines 39-51, "14.", column 34, lines 31-65). The stabilizers are employed for stabilizing organic materials against the harmful effects of light, oxygen, and/or heat (see abstract). The compound may be added to a layer containing a UV absorber such as a protective layer or a layer between the red and green sensitive emulsion layers (an interlayer). The green sensitive emulsion layer contains a magenta coupler which is a pyrazolopyrazole, pyrazolotriazole, or pyrazolotetrazole (column 34, line 1 to

Art Unit: 1752

column 35, line 57). From the weight of the polymer coating composition in column 59, and the teaching in column 29 that the stabilizer may be added in an amount of 0.1 to 5 % by wt of the polymer (s), the amount of stabilizer added to the layer (s) would fall within the scope of the present claim 8.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al in view of Hinsken et al (4,325,863).

Birbaum et al has been discussed above, but fails to specifically describe a compound meeting the limitations of the present formula VI. The reference cites Hinsken et al as describing suitable benzofuranone compounds. Those exemplified by Hinsken et al teach that the present R2 and R4 groups may contain pentyl groups (as in the present formula IV) and teach that they are equivalent to butyl groups (see compound 8).

Given the teaching of Hinsken et al that suitable substituents for positions R2 and R4 include pentyl groups, it would have been obvious to one of ordinary skill in the art to prepare the material of Birbaum et al using the benzofuranone compounds described in "14" of column 29 replacing the butyl group with a pentyl group given that they are taught to be equivalent by

Art Unit: 1752

the reference, with reasonable expectation of forming a material having increased protection against light, oxygen, and/or heat.

Response to Arguments

6. Applicant's arguments filed 11/13/2002 have been fully considered but they are not persuasive.

Applicant has argued that the benzofuranone compounds of Birbaum have not been taught to function as oxidized developer scavengers. As discussed above, the compounds of Birbaum appear to meet the structural limitations of the present claims, thus it is the position of the examiner that when added to the material these compounds would function in the same manner as those presently claimed regardless of the purpose of addition given by the reference. Absent evidence to the contrary, the examiner maintains her rejection.


Applicant has also argued that the new limitation requiring that the compound be added to an interlayer of the photographic material, as pointed out in the 102 rejection above, the reference specifically mentions adding the compound to an interlayer. Therefore the examiner maintains her rejection in light of the amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1752

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


ACW
March 9, 2003

Amanda C Walke
Examiner
Art Unit 1752


JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700